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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,026	09/24/2003	Bruce Karsh	50269-0562	7849

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EXAMINER	
FRISBY, KESHA	

ART UNIT	PAPER NUMBER
3715	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/671,026	KARSH ET AL.	
	Examiner	Art Unit	
	KESHA FRISBY	3715	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 February 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-6 and 8-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-6 and 8-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

After the amendment was filed on 2/26/2009, claims 1-6 & 8-13.

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1 & 8 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 & 4 of U.S. Patent No. 7,464,020 in view of McGreevy (U.S. Publication Number 2003/0004914). The instant application consists of broader claim terminology that the U.S. Patent No. 7,464,020. Further, claim 1 recites receiving data that specifies a first form of a component word; locating, within said compound word, a second form of said component word that differs from said first form of said component word; and

displaying said compound word with said second form of said component word visibly distinguished from the remainder of said compound word: wherein the steps of receiving, locating and displaying are performed by a search engine executing in a computer system (where claim 8 recites similar claim language). It is clear that all the elements of claims 1 & 8 are to be found in claims 1 & 4. The difference between claim 1 of the application and claims 1 & 8 of the patent is that claim further recites a second form of said component word that differs from said first form of said component. McGreevy teaches searching/locating a second form of said component word that differs from said first form of said component word performed by a search engine executing in a computer system (paragraphs 0097-0189). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include searching/locating a second form of said component word, as disclosed by McGreevy, incorporated into Bharat et al., in order to match alternative terms of the query term with the query term.

3. Claims 4 & 11 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 & 2 of U.S. Patent No. 7,464,020). Although the conflicting claims are not identical, they are not patentably distinct from each other because it is clear that all the elements of claims 4 & 11 are to be found in claims 1 & 2. The difference between claims 4 & 11 of the application and claims 1 & 2 lies in the fact that the patent claim includes many more elements and is this much more specific. Thus the invention of claims 1 & 2 of the patent is in effect a "species" of the "generic" invention of claims 4 & 11. It has been held that the generic

invention is "anticipated" by the "species". Se In re Goodman, 29 USPQ2d 2010 (Fed. Cir. 1993). Since claims 4 & 11 are anticipated by claims 1 & 2 of the patent, it is not patentably distinct from claims 1 & 2.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1 & 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bharat et al. (U.S. Patent Number 7,249,121) in view of McGreevy (U.S. Publication Number 2003/0004914) and Evans et al. (U.S. Patent Number 6,363,179).

Referring to claims 1 & 8, Bharat et al. discloses receiving data that specifies a first form of a component word (column 1 line 50-column 4 line 62 & column 6 line 40-54) performed by a search engine executing in a computer system (search engine); locating, within said compound word said component word (column 1 line 50-column 4 line 42 & column 6 lines 40-54) performed by a search engine executing in a computer system (search engine). *Bharat et al. does not disclose searching/locating a second form of said component word that differs from said first form of said component word performed by a search engine executing in a computer system and displaying said compound word with said second form of said component word visibly distinguished from the remainder of said compound word performed by a search engine executing in a computer system.* McGreevy teaches searching/locating a second form of said

component word that differs from said first form of said component word performed by a search engine executing in a computer system (paragraphs 0097-0189). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include searching/locating a second form of said component word, as disclosed by McGreevy, incorporated into Bharat et al., in order to match alternative terms of the query term with the query term. *Bharat et al./McGreevy does not teach displaying said compound word with said second form of said component word visibly distinguished from the remainder of said compound word performed by a search engine executing in a computer system.* However, Evans teaches where a search engine displays a word to make it visibly distinguished from the remainder of said word performed by a search engine executing in a computer system (Fig. 4a, elements 404-408 & column 5 lines 30-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include visibly distinguishing, as disclosed by Evans et al., incorporated into Bharat et al./McGreevy in order to determine which parts of a document match search terms when displaying an image of a document and for making it easier for a user to determine whether a matching document is relevant.

6. Claims 2 & 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bharat et al./McGreevy/Evans et al. and further in view of Hofert et al. (U.S. Patent Number 5,337,233).

Referring to claims 2 & 9, Bharat et al./McGreevy/Evans et al. discloses the limitations of claims 1 & 8 and said compound word is a non-English language word (paragraphs 0142-0158of McGreevy). *Bharat et al./McGreevy/Evans et al. does not disclose*

wherein said second form of said compound word is a superlative form of said first form of said compound. However, Hofert et al. teaches allowing a technique known as "wildcarding", where "wildcarding" gives the search engine the opportunity to select any instance where additional characters appear in or after the position of the "wildcard" character (column 10 lines 47-55). Therefore, Hofert et al. is capable of locating superlatives, so it would have been obvious to one of ordinary skill in the art at the time the invention was made to include wherein said second form of said compound word is a superlative form of said first form of said compound word as disclosed by Hofert et al., incorporated into Bharat et al./McGreevy/Evans et al. in order disclose a superlative form of an adjective.

7. Claims 3 & 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bharat et al./McGreevy/Evans et al. and further in view of Noble (U.S. Patent Number 6,729,882).

Referring to claims 3 & 10, Bharat et al./McGreevy/Evans et al. discloses the method of claim 1. *Bharat et al./McGreevy/Evans et al. does not disclose wherein said second form of said component word does not contain said first form of said component.* However, Noble teaches plurals (column 1 lines 50-52). Therefore, Noble is capable of teaching wherein said second form of said component word does not contain said first form of said component. So, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include wherein said second form of said component word does not contain said first form of said component, as disclosed by

Noble, incorporated into *Bharat et al./McGreevy/Evans et al.*, in order to teach students how to perform plurals.

8. Claims 4 & 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bharat et al. in view of Noble and Evans et al..

Regarding claims 4 & 11, Bharat et al. discloses determining a first stem word associated with said compound word (column 1 line 50-column 4 line 24 & column 6 lines 40-54) and displaying said compound word with letters at and between said starting position associated with said first stem word and said ending position associated with said first stem word (column 1 line 50-column 4 line 24 & column 6 lines 40-54). *Bharat et al. does not disclose based on a comparison between letters in said first stem word and said compound word, determining a first starting position; based on a comparison between letters in said second stem word and said compound word, determining a second starting position; determining, based on said first starting position and said second starting position, a starting position associated with said first stem word; determining, based on said first starting position and said second starting position, an ending position associated with said first stem word and visibly distinguished from the remainder of said compound word.* However, Noble teaches based on a comparison between letters in said first stem word and said compound word, determining a first starting position (starting with the letter "b" of "bloodhound" & column 28 line 25-column 29 line 31); based on a comparison between letters in said second stem word and said compound word, determining a second starting position (starting with the letter "h" & column 28 line 25-column 29 line 31); determining, based

on said first starting position and said second starting position, a starting position associated with said first stem word (starting with the letter "h" & column 28 line 25-column 29 line 31); determining, based on said first starting position and said second starting position, an ending position associated with said first stem word (ending with the letter "d" & column 28 line 25-column 29 line 31). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include starting and ending positions, as disclosed by Noble, incorporated into Bharat et al. in order to distinguish the two or more juxtaposed words from each other within a compound word. *Bharat et al./Noble does not disclose visibly distinguishing from the remainder of said compound word.* However, Evans teaches visibly distinguishing from the remainder of said word performed by a search engine executing in a computer system (Fig. 4a, elements 404-408 & column 5 lines 30-67). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include visibly distinguishing, as disclosed by Evans et al., incorporated into Bharat et al./Noble in order to determine which parts of a document match search terms when displaying an image of a document and for making it easier for a user to determine whether a matching document is relevant.

9. Claims 5, 6, 12 & 13 rejected under 35 U.S.C. 103(a) as being unpatentable over Bharat et al./Noble/Evans et al. and further in view of Koehn (U. S. Publication Number 2005/0033565).

Referring to claims 5, 6, 12 & 13, Bharat et al./Noble/Evans et al. discloses the method of claim 4. *Bharat et al./Noble/Evans et al. does not disclose wherein determining said*

first starting position comprises: determining, for a first sequence of letters in said compound word, a first score based on how many letters in said first sequence match letters in said first stem word; determining, for a second sequence of letters in said compound word, a second score based on how many letters in said second sequence match letters in said first stem word; and determining said first starting position based on said first score and said second score. Noble also does not disclose wherein determining said second starting position comprises: determining, for a third sequence of letters in said compound word, a third score based on how many letters in said third sequence match letters in said second stem word; determining, for a fourth sequence of letters in said compound word, a fourth score based on how many letters in said fourth sequence match letters in said second stem word; and determining said second starting position based on said third score and said fourth. However, Koehn teaches determining, for a first sequence of letters in said compound word, a first score based on how many letters in said first sequence match letters in said first stem word; determining, for a second sequence of letters in said compound word, a second score based on how many letters in said second sequence match letters in said first stem word; and determining said first starting position based on said first score and said second score (paragraphs 0020-0040). Koehn also teaches wherein determining said second starting position comprises: determining, for a third sequence of letters in said compound word, a third score based on how many letters in said third sequence match letters in said second stem word; determining, for a fourth sequence of letters in said compound word, a fourth score based on how many letters in said fourth sequence

match letters in said second stem word; and determining said second starting position based on said third score and said fourth score (paragraphs 0020-0040). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include determining first, second, third and fourth sequences of letters, as well as, determining the first and second starting positions, as disclosed by Koehn, incorporated into Bharat et al./Noble/Evans et al. in order to know where to start highlighting.

Response to Arguments

10. Applicant's arguments with respect to claims 1-6 & 8-13 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KESHA FRISBY whose telephone number is (571)272-8774. The examiner can normally be reached on Monday-Friday 8am-4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Kesha Frisby
Examiner
Art Unit 3715

/Kesha Frisby/
Examiner, Art Unit 3715 7/10/2009